

### REMARKS

Claims 1-9 are pending. Claim 3 has been amended to comply with the objection raised by the Examiner.

A double patenting rejection of pending claims 3, 5 and 7 have been made by the Examiner on the basis that these claims are the same as claims 1, 3 and 7 of US Pat. No. 6,766,963. Pending claims 3, 5, and 7 are not the same because the strength enhancing polymer in the '963 patent is in the range of 0-0.5% while the range is 0-5% in pending claims 3, 5 and 7. Because the compositional range is different, the Examiner is asked to withdraw this rejection.

The Examiner has rejected all pending claims based upon 5 prior art references; namely, Shea (US 6,179,215), Jury et al (US 6,262,175), Oestmann (US 5,104,039), Marinelli (US 6,247,651) and Smith (US 6,021,958).

#### Claims 1 and 8

The Examiner bases his 103 rejection upon the conclusion that it would have been obvious to one of ordinary skill at the time of the invention to modify Shea to include the use of a weight ratio of 10-35% recycled natural rubber to 65-90% recycled vulcanized rubber as taught by Jury et al. to obtain the crosstie of claims 1 and 8.

Contrary to the Examiner's statement that Shea discloses a product containing an extruder crosstie, Shea discloses *a pair of extruded lengths* that together define an outer casing when assembled. However, before these extruded lengths are assembled, reinforcing beams are disposed into the cavity formed when the extruded lengths are mated. Shea Col 1, line 65 – Col 2, line 2. Therefore, each of the extruded lengths are not crossties and a crosstie, according to Shea is not formed until the reinforced beam, preferably made of steel (Col. 2, lines 13-16) is positioned between the extruded lengths and the voids filled with concrete.

Claim 1 states in the preamble that the crosstie is made "substantially from recycled rubber". Claim 8 states 10-35% of the "crosstie weight" is recycled vulcanized crumb rubber and 65-90% of the "crosstie weight" is recycled vulcanized rubber. In comparison, Shea is not made substantially from recycled rubber, but from rubber sufficient to form only an outer casing, with concrete and reinforced steel disposed within.

Claims 1 and 8 are therefore sufficiently distinct from the cited prior art.

### **Claim 2**

Claim 2 depends from claim 1. Since Applicant has shown that the Shea and Jury et al. references do not teach the method of claim 1. In view of the argument presented for claim 1 above, claim 2 should be in a condition for allowance.

### **Claims 3 and 5**

The Examiner bases his rejection of claims 3 and 5 under 103 as being unpatentable over Marinelli in view of Jury et al.

Marinelli teaches a specific composite composition for a crosstie; that being 65% recycled plastic, 20% crumb rubber and 15% reinforcing fibers. There is no teaching in Marinelli to deviate from this composition. Further, it is not in the realm of obviousness that the composition percentages of Marinelli can be replaced with the composition percentages disclosed in Jury et al. This is because there is no teaching in Marinelli or in Jury et al, that suggest or teach that the composition disclosed in Jury et al. can be used for crossties. Combining of the references is therefore improper.

### **Claims 4, 6 and 7**

The Examiner bases his rejection of claims 4, 6 and 7 under 103 as being unpatentable over Marinelli and Jury et al. in further view of Smith.

Claims 4, 6 and 7 depend from claims 3. Since Applicant has shown that the Marinelli and Jury et al. references do not teach the method of claim 3. In view of the argument presented for claims 3 and 5 above, claims 4, 6 and 7 should be in a condition for allowance.

### CONCLUSION

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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